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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Sergey Golovashchenko, et al.

Serial No.: 10/710,712

Group Art Unit: 3724

Filed: July 29, 2004

For: APPARATUS FOR TRIMMING METAL

Attorney Docket No: 200-1213/81107524 (FGT 1917 PA)

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RESPONSE TO OFFICE ACTION

This paper is in response to the Office Action in the above-entitled application, mailed December 4, 2006. This response is timely because it is being filed within the one month period set for a response.

The Applicant respectfully selects group VI with traverse in response to the Examiner's restriction requirement. Group VI would require the examination of claims 1,4,5,9,10,12,16, and 17 as indicated by the Examiner in the office action.

The Applicant, however, respectfully traverses the restriction requiring election. The Examiner states that the sub combinations in groups I-VII are usable together and would represent an excessive burden to the office to examine together. MPEP 808.02, however, requires the Examiner to show either:

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- a) Separate classification of these groups. Yet they are all limitations within an apparatus for trimming metal. The Examiner has not shown that invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search". Rather these limitations, as recognized by the Examiner, could easily have been included in a single independent claim wherein an identical search of a single subject matter would have been required. The number of limitations in a claim, alone or by way of dependents, does not satisfy the "group classification" as defined in MPEP 808.02
- b) Separate status in the art when they are classified together. The MPEP indicates that this may be shown by way of citing patents which are evidence of separate status or separate field of search. An argument regarding the number of search "terms" does not satisfy nor is indicative of a separate field of search or separate status in the art. Rather the limitations classified in the separated groups are all inventive limitations for use in the metal trimming apparatus claimed and therefore represent a single field and a single status in the art.
- c) Finally, the Examiner could have given evidence that a separate field of search would have been required. It appears as though this is the basis asserted by the Examiner. However, to succeed under this basis the Examiner must show that "it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s)". The Examiner's assertion that he would be required to use "different search queries" is disingenuous. The fields are identical for each group. As the fields are identical, a search in one field would produce relevant art for the others "apparatus for metal trimming". If one were simply to allow the need for multiple search terms alone to serve as the basis for restrictions, every dependent claim of every patent could be restricted out under this basis. If a new limitation is added in a dependent claim, a new search term "COULD" be utilized. This, however, is not to say that this is evidence that a field search for the subject matter of the independent claims would not turn up all relevant art for the dependent claims. Nor is it evidence of an unduly burdensome search process.

Therefore, the Examiner is petitioned to reconsider his restriction requirement in light of the aforementioned traversal.

Respectfully submitted,



Thomas E. Donohue
Reg. No. 44,660
Artz & Artz, P.C.
28333 Telegraph Road, Suite 250
Southfield, MI 48034
(248) 223-9500
(248) 223-9522 (Fax)

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